



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,709	05/03/2005	Said Mansouri	MANSOURI, S. - 1 PCT	9628
25889	7590	12/04/2007		
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER MEHTA, BHISMA	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 12/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,709	Applicant(s) MANSOURI, SAID	
	Examiner Bhisma Mehta	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-16, 18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-16, 18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The phrase "which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a)" should not be used in the declaration and should be replaced with "which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56".

Drawings

2. The drawings were received on September 10 2007. These drawings are acceptable.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 8-16, 18-20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. In claims 1, 19, and 22, it is unclear if the slide valve is being claimed as having a front element protruding in the first hydraulic chamber or if the slide valve pressure plate is being claimed as having a front element protruding in the first hydraulic chamber. Also, it is unclear if the front element recited in line 2 of claim 8 refers to the front element already recited in claim 1 or if another front element is being claimed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 8-16, 18, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Haar et al (U.S. Patent No. 6,440,099). In Figure 2, Haar et al show a syringe having a feed piston (18a) that is longitudinally slidable in a carpule volume and that has a pressure plate (21a) which is connected to a first hydraulic chamber (adjacent to the pressure plate) and a second hydraulic chamber (34a) which is behind and connected to the first hydraulic chamber. A slide valve (33) is capable of closing or progressively opening an opening of a control hole between the first and second chambers. The slide valve has a pressure plate which is connected to the first hydraulic chamber and a front element of the slide valve or the slide valve pressure plate projects into the first hydraulic chamber. The front element is considered to be capable of

allowing for haptic feedback of the pressure in the first hydraulic chamber. As to claims 9 and 10, a touch-sensitive key pad (32) causes the control hole to open at least substantially parallel to the axis of movement of the slide valve when pressed and is disposed at least partially in a front half of the syringe. The axis of movement of the slide valve is disposed perpendicular to a longitudinal axis of the syringe. The slide valve is biased with a biasing force closing the control hole where the biasing force is the force that keeps the key pad in the position shown in Figure 2. As to claims 13-16, the valve (33) is considered to be the indexer piston that is connected to the first hydraulic chamber where a foot of the indexer piston projects into the first chamber. The indexer piston is slidably mounted and has a limit stop (the portion of the syringe where the key pad abuts the syringe in Figure 2). The indexer piston is considered to be mounted such that it is biased against an exit direction. As to claim 18, the feed piston completely lies within a feed cylinder (23). As to claim 22, the position of the indexer piston within the syringe (i.e. as positioned in Figure 2 and as positioned in Figure 3) would make the pressure in the hydraulic chamber optically recognizable.

7. Claims 1-4, 8-12, 18-20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Love (U.S. Patent No. 2,650,591). In Figure 7, Love shows a syringe having a feed piston (10) that is longitudinally slidable in a carpule volume and that has a feed piston pressure plate which is connected to a first hydraulic chamber (25) and a second hydraulic chamber (28) which is behind and connected to the first hydraulic chamber. The syringe has a slide valve (37) with a slide valve pressure plate (27) connected to the first hydraulic chamber with a front element (38) of the slide valve or

the slide valve pressure plate protruding into the first hydraulic chamber to allow for haptic feedback of the pressure in the first hydraulic chamber. The slide valve (37) is capable of closing and progressively opening an opening of a control hole between the first and second hydraulic chambers. A separator piston (29) is disposed behind the second hydraulic chamber and is slidably mounted such that it is capable of reducing the size of the second chamber and of enlarging a pressurization space (i.e. the space within the first hydraulic chamber). The second hydraulic chamber would be caused to become smaller by the same amount as the pressurization space would be enlarged. As to claims 9 and 10, a touch-sensitive key surface (41) causes the control hole to open at least substantially parallel to the axis of movement of the slide valve when pressed and is disposed at least partially in a front half of the syringe. The axis of movement of the slide valve is disposed perpendicular to a longitudinal axis of the syringe. The slide valve is biased with a biasing force to close the control hole in the form of portion (39) of the slide valve. As to claim 18, the feed piston completely lies within a feed cylinder (21).

Response to Arguments

8. Applicant's arguments with respect to claims 1-4, 8-16, 18-20, and 22 have been considered but are moot in view of the new ground(s) of rejection. As to Applicant's arguments on pages 12 and 13 regarding Haar et al, the front element of Haar et al is considered to be capable of allowing for haptic feedback of the pressure in the first hydraulic chamber. As the slide valve (33) is being pressed, the front element protrudes

into the first hydraulic chamber and is capable of providing haptic feedback of the pressure. Applicant argues that "regulation" as recited in the claims is to be understood as "continuous regulation". This is not persuasive as there is no indication of continuous regulation in the claims. In response to applicant's argument that the slide valve of Haar et al is not capable of closing or progressively opening the opening of the control hole, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the slide valve of Haar et al is shown to be capable of progressively opening the opening of the control hole.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Application/Control Number:
10/533,709
Art Unit: 3767


Page 7

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bhisma Mehta whose telephone number is 571-272-3383. The examiner can normally be reached on Monday through Friday, 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


BM

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

